

REMARKS

I. Status of the Claims

Claims 1-117 are pending. Without prejudice or disclaimer, claims 1, 27, 89, and 115-117 are amended herein to recite that the composition contains less than 5% by weight, relative to the total weight of the composition, of a volatile oil. Also without prejudice or disclaimer, claims 116 and 117 are further amended herein to recite at least one high-viscosity phenylsilicone oil has a viscosity of greater than or equal to 500 cSt. Support for these amendments can be found in the specification and claims as-originally filed, e.g., Specification as-published (U.S. Patent Application Publication No. 2004/0126350 A1) at ¶ [0099]. In addition, claim 118 is added herein. Support for this claim can be found in the claims as-originally filed. Thus, no new matter is presented.

Applicants acknowledge and thank the Examiner for withdrawing the Restriction Requirement.

II. Rejections Under 35 U.S.C. § 102

A. 102(e) Rejection based Willemin

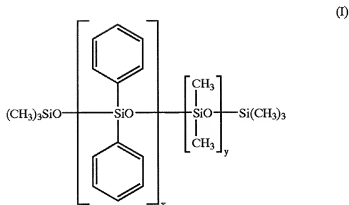
The Examiner rejects claims 1-22, 24-26, 60-81, 83-110, and 112-117 under 35 U.S.C. § 102(e) as being allegedly anticipated by U.S. Patent No. 6,592,855 to Willemin et al. ("Willemin"). See Office Action at 2-4. According to the Examiner, "Willemin teaches diphenyldimethicones as in formula 1," which are allegedly the same as the claimed high viscosity phenylsilicone oils. Office Action at 3 (citing Willemin, Abstract; Claims; and col. 2, lines 1-51). The Examiner reasons that the disclosed diphenyldimethicones as in formula 1 of Willemin will inherently have the same viscosity because formula (A) of claim 18 is within the same scope as formula 1 of Willemin. *Id.*

Moreover, the Examiner alleges that the compositions of Willemin contain a fatty body, which includes "fatty esters comprised of fatty acids and alcohols with 5-30 carbon atoms or just the fatty acids and alcohols on their own, the amount of fatty esters could be as high as 20% as shown in the examples." Office Action at 3 (citing Willemin, col. 3, lines 9-29 and Examples). Applicants respectfully traverse this rejection for at least the following reasons.

A reference anticipates a claim only if "each and every element as set forth in the claim is found, either expressly or inherently described." See M.P.E.P. § 2131 (quoting *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987)). As Willemin does not teach each and every element of the present claims, this rejection is improper and Applicants respectfully request that it be withdrawn.

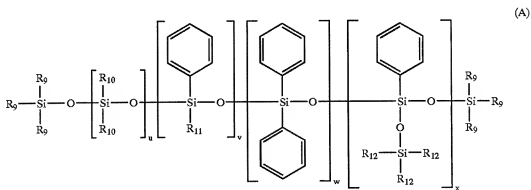
As noted above, the Examiner asserts that "Willemin teaches diphenyldimethicones as in formula 1," which are allegedly the same as the claimed high viscosity phenylsilicone oils. Office Action at 3. Applicants respectfully disagree. Willemin identifies the diphenyldimethicone of formula (I) as a "silicone gum." Willemin, col. 2, lines 1-2 (emphasis added). A silicone gum is different than the presently claimed at least one phenylsilicone oil. Indeed, the present specification expressly excludes the possibility of phenylsilicone gums by stating that the "silicone oil is suitably not a silicone gum." Specification as-published at ¶ [0030].

The different nature of the disclosed diphenyldimethicone gums of formula (I) of Willemin is shown at least by the chain length. Specifically, formula (I) of Willemin:



states that "x represents the number of recurring units which is generally not very high, preferably less than about 500, advantageously between about 50 and about 150, even better between about 80 and about 120, while y represents the number of recurring units which is generally higher, preferably at least equal to 1,000 and even better between about 1,000 and about 2,000." Willemin, col. 2, lines 18-24. Thus, the gums taught by Willemin advantageously contain chains at a minimum of 1,050 in length.

In contrast, the presently claimed at least one high viscosity phenylsilicone oil corresponding to formula (A):



states that "u, v, w and x, which may be identical or different, are integers ranging from 0 to 900, with the provisos that the sum v+w+x is other than 0, and that the sum

u+v+w+x ranges from 1 to 900; for example, u+v+w+x ranges from 1 to 800." Thus, the gum chains of Willemin are least 200 units longer than the presently claimed oils.

At least because Willemin does not teach or suggest the presently claimed at least one phenylsilicone oil, Applicants respectfully submit that this rejection is improper and should be withdrawn.

Moreover, contrary to the Examiner's position, Willemin does not inherently teach the claimed viscosity. A reference inherently discloses something only when it would inevitably produce the later-claimed invention. See M.P.E.P. § 2112(IV) ("The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.") (emphasis in original). Thus, to be inherent, the alleged result must be inevitable from the operation disclosed or the inherent characteristic must be inevitably present in the device. See, e.g., *Akamai Techs., Inc. v. Cable & Wireless Internet Servs., Inc.*, 344 F.3d 1186, 1192, 68 U.S.P.Q.2d 1186, 1190 (Fed. Cir. 2003) ("A claim limitation is inherent in the prior art if it is necessarily present in the prior art, not merely probably or possibly present."); *Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1295, 63 U.S.P.Q.2d 1597, 1599 (Fed. Cir. 2002) ("Inherent anticipation requires that the missing description material is 'necessarily present,' not merely probably or possibly present, in the prior art.").

At best, it is merely probable or possible that the disclosed diphenyldimethicones as in formula (I) of Willemin have a viscosity greater than or equal to 500 sCt. This does satisfy the standard for inherency, and Willemin, therefore, cannot inherently teach the claimed viscosity of greater than or equal to 500 sCt. Accordingly, Applicants respectfully submit that the rejection should be withdrawn for this reason as well.

Finally, independent claim 1 recites at least one non-volatile hydrocarbon having a molecular mass of more than 500 g/mol and independent claims 60, 89, and 115-117 recite at least one non-volatile hydrocarbon oil having a molecular mass of more than 600 g/mol. Willemin does not teach or suggest at least one non-volatile hydrocarbon oil having a molecular mass of more than 500 g/mol or 600 g/mol. Willemin provides some examples of the fatty phase (see Willemin at col. 3, lines 5-29), but does not state whether they possess a molecular mass of more than 500 g/mol or 600 g/mol. Because Willemin does not teach or suggest using at least one non-volatile hydrocarbon oil having a molecular mass of more than 500 g/mol or 600 g/mol, Willemin does not anticipate the claimed invention and Applicants respectfully submit that the rejection should be withdrawn for this additional reason.

Because claims 2-22, 24-26, 61-81, 83-88, 90-110, and 112-114 depend, either directly or indirectly, from independent claims 1, 60, or 89, they are not anticipated by Willemin for the reasons discussed above. Thus, Applicants respectfully request that the Examiner withdraw the rejection of these claims as well.

B. 102(b) Rejection based Arnaud¹

The Examiner rejects claims 1-13, 18-19, 24-39, 44-45, 50-72, 77-78, 83-101, 106-107, and 112-117 under 35 U.S.C. § 102(b) as being allegedly anticipated by U.S. Patent Application Publication No. 2001/0031269 to Arnaud ("Arnaud"). See Office Action at 4-5. According to the Examiner, "Arnaud teaches cosmetic compositions comprising 0.5 to 90% non-volatile silicone compound (including numerous phenyl siloxanes that would meet applicants claimed formula) and 5 to 90% of non-volatile hydrocarbon based oil including diisostearate malate, diglycerol diisostearate and diglycerol trisostearate." *Id.* at 4 (citing Arnaud, Abstract; ¶¶ [0056], [0057], [0080]-[0084]). The Examiner further argues that the claimed viscosity limitations are inherently taught by Arnaud because "Arnaud teaches the same phenylsiloxanes as claimed by applicants," and "Arnaud also teaches the use of 0-50% by weight of waxes including polyethylene waxes, microcrystalline waxes, ect [sic] and silicone waxes with pendent chains of alkyl and alkoxy type containing 8 to 24 carbons." *Id.* at 5 (citing Arnaud, ¶¶ [0108]-[0110]). Applicants respectfully traverse this rejection for at least the following reasons.

Although Applicants disagree with the Examiner's rejection, in order to expedite prosecution, Applicants have amended claims 1, 27, 89, and 115-117 herein to recite

¹ Although the Examiner makes this rejection under 35 U.S.C. § 102(b), Arnaud is not a proper § 102(b) reference. However, Applicants still address this rejection without conceding the propriety of Arnaud as a prior art reference.

that the composition contains less than 5% by weight, relative to the total weight of the composition, of a volatile oil.² Arnaud does not teach or suggest this limitation.

In particular, Arnaud teaches a composition, which contains, among other things, at least one volatile hydrocarbon-based solvent present in an amount ranging from 5% to 90%, most preferably 20% to 50%. See Arnaud, ¶¶ [0083]-[0084]. Although Arnaud identifies the hydrocarbon-based compounds as “solvents,” one skilled in the art would recognize that these “solvents” listed by Arnaud are volatile oils. Further, one skilled in the art, however, would understand from the context of Applicants’ specification and Arnaud that the volatile oils do not encompass silicone and fluoro oils. *Compare* Specification as-published at ¶ [0099] *with id.* at ¶¶ [0100]-[0102]; *compare* Arnaud, ¶ [0083] *with id.* at ¶ [0097].

Accordingly, because Arnaud teaches using a volatile oil in an amount ranging from 5% to 90%, most preferably 20% to 50%, rather than in an amount less than 5%, as presently claimed, Arnaud does not anticipate the presently claimed invention. Thus, Applicants respectfully request that the Examiner withdraw this rejection.

Because claims 2-13, 18-19, 24-26, 28-39, 44-45, 50-59, 61-72, 77-78, 83-88, 90-101, 106-107, and 112-114 depend, either directly or indirectly, from independent claims 1, 27, 60, and 89, they are not anticipated by Willemin for the reasons discussed above. Thus, Applicants respectfully request that the Examiner withdraw the rejection of these claims as well.

² It was not necessary to similarly amend independent claim 60 as it already contained this limitation when the application was filed.

III. Rejection Under 35 U.S.C. § 103(a)

The Examiner rejects claims 1-117 under 35 U.S.C. § 103(a) as being allegedly unpatentable over Willemin in view of Arnaud. See Office Action at 6-8. The Examiner relies on Willemin for the reasons stated above and also argues that it would have been obvious to one skilled in the art "to vary the proportions of the phenylsiloxanes over a wide range through routine experimental practice in order to arrive at the desired properties and/or consistency of the composition." *Id.* at 6-7. The Examiner concedes that Willemin "does not disclose the use of silicone waxes as claimed by applicants," but relies on Arnaud to allegedly cure this deficiency, arguing that "it was already well known in the art at the time of the invention to include mixtures of waxes including silicone waxes in cosmetic compositions." *Id.* at 7. Applicants respectfully traverse for at least the following reasons.

Several basic factual inquiries must be made in order to determine the obviousness or non-obviousness of claims of a patent application under 35 U.S.C. § 103. These factual inquiries, set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 U.S.P.Q. 459, 467 (1966), require the Examiner to:

- (1) Determine the scope and content of the prior art;
- (2) Ascertain the differences between the prior art and the claims in issue;
- (3) Resolve the level of ordinary skill in the pertinent art; and
- (4) Evaluate evidence of secondary considerations.

The obviousness or nonobviousness of the claimed invention is then evaluated in view of the results of these inquiries. *Graham*, 383 U.S. at 17-18, 148 U.S.P.Q. 467; see also *KSR Int'l Co. v. Teleflex, Inc.*, 82 U.S.P.Q.2d 1385, 1391 (2007).

Thus, in order to carry the initial burden of establishing a *prima facie* case of obviousness that satisfies the *Graham* standard, the Examiner must at least show (1) that the prior art reference teaches or suggests all the claim limitations, (2) that there is some suggestion or motivation, either in the reference or in the knowledge generally available to one skilled in the art, to modify the reference, and (3) that there is some reasonable expectation of success. See M.P.E.P. § 2143.

Here, with respect to the scope and content of the prior art, neither Willemin nor Arnaud teach or suggest all the limitations of the claimed invention, and, thus, a *prima facie* case of obviousness has not been established.

Although Willemin teaches that the disclosed composition may contain a silicone oil in an amount ranging from 1 to 10% by weight (see Willemin, col. 4, lines 4-7), as discussed above, the present invention excludes silicone oils from the possible volatile oils. Arnaud fails to cure this deficiency. As noted above, Arnaud fails to teach or suggest a composition containing less than 5% by weight, relative to the total weight of the composition, of a volatile oil. Because neither Willemin nor Arnaud teaches or suggests a composition containing less than 5% by weight, relative to the total weight of the composition, of a volatile oil, the Examiner has not established a *prima facie* case of obviousness at least because neither reference teaches or suggests each and every limitation of the presently amended claims. For at least this reason, Applicants respectfully request that the rejection be withdrawn.

Conclusion

In view of the foregoing remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

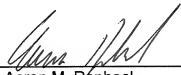
If the Examiner believes a telephone conference could be useful in resolving any outstanding issues, he is respectfully invited to contact Applicants' undersigned counsel at (202) 408-4152.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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By: 

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